

REMARKS

In the Restriction Requirement mailed September 30, 2005, the Examiner has restricted the claims to one of the following inventions under 35 U.S.C. 121:

- I. Claims 95-106, drawn to a method of regulating output of a signal, substance or action in a subject, classified in class 600, subclass 300.
- II. Claims 59-94, drawn to an implantable physiological or pathophysiological biosensor, classified in class 600, subclass 300.

Applicant provisionally elects, with traverse, Group II (claims 59-94), species F (implantable physiological or pathophysiological biosensor comprising in vitro or ex vivo modified stem cells), species 4 (monitored physiological or pathophysiological variable is a level or activity of at least one of blood glucose, insulin, thyroid hormone, clotting factors or components, endocrine hormone, paracrine hormone, autocrine hormone, antibodies, receptor antagonists, ligands, antigens, antagonists, signal pathway cofactors, signal pathway components, pathogens, drugs, metabolites, or toxins) and species 6 (biosensor implanted or inserted in a human).

Applicant traverses the Requirement for Restriction below. If the Examiner does not withdraw or modify the Requirement for Restriction, Applicant respectfully requests that the Examiner consider the unelected claims (and species) after allowance of a generic claim relating to the elected claims (and species), and Applicant reserves the right to reintroduce the unelected claims in one or more divisional applications at a later date.

The Restriction Requirement is traversed on the basis that Restriction Requirements are optional in all cases (M.P.E.P. § 803). If the search and examination of an entire application can be made without serious burden, the Examiner must examine the application on the merits, even though it includes claims to distinct or independent inventions. M.P.E.P. § 803. Evidence that the claims in Groups I-II can be effectively and efficiently searched in a single search with no additional burden placed on the Examiner is provided in the Restriction Requirement, as those claims are in the same class (600) and same subclass (subclass 300) for search purposes.

Applicants also respectfully traverse the requirement for electing three different species of (F, 4 and 6). As provided by the MPEP, species may be related inventions and need not be subject to restriction. *See* MPEP § 806.04(b). In particular, where species are claimed under a common genus and are related, the question of restriction is determined by the practice applicable to election of species and the practice applicable to other types of restrictions. *See id.* Applicants also respectfully remind the Examiner that they are entitled to examination of a reasonable number of species, and that election of species is for the convenience of the Examiner in initiating the search.

Here, at least claim 74 is generic with regard to species F, 4 and 6. This generic claim explicitly defines how the claimed species are related. The Examiner is reminded that M.P.E.P. § 803.02 states that “if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the Examiner will not . . . require restriction. [S]hould no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended . . . to the extent necessary to determine patentability of the Markush-type claim.” (Emphasis added.)

Applicant requests reconsideration of the requirement for election of three different species. If this request is denied, Applicant submits that additional species should be considered as required under M.P.E.P. § 803.02, if a prior art search of the elected species turns up no relevant prior art. Applicant also reserves the right to file divisional application(s) on the non-elected claims and/or species.

RESPONSE TO RESTRICTION REQUIREMENT

Serial Number: 10/690,798

Filing Date: October 21, 2003

Title: ENHANCED BIOLOGICALLY BASED CHRONOTROPIC BIOSENSING

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Dkt: 1676.001US2

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (516) 795-6820 to facilitate prosecution of this application.

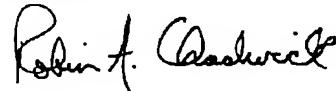
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JAY EDELBURG ET AL.

By their Representatives,

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Date October 31, 2005

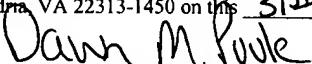
By _____

Robin A. Chadwick

Reg. No. 36,477

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st day of October, 2005.

Name



Signature

